

#17
PATENT**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Richard E. Vogel and Timothy J. Foltz
 For: CONFECTION CUP ASSEMBLY
 Serial No.: 09/681,099 Examiner: Joseph C. Merek
 Filed: January 4, 2001 Group Art Unit: 3727
 Atty. Docket: 70254-328 Confirmation No.: 8152

NOV 6 2003
GROUP 3700**FAX RECEIVED**

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GROUP 3700**PETITION TO THE DIRECTOR****FAX RECEIVED**

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PETITIONS OFFICE

Under 37 C.F.R. §1.181(a)(3), Applicants petition to invoke the supervisory authority of the Director. More specifically, Applicants ask the Director to instruct the Examiner to either (a) file an answer to Applicants' appeal or (b) enter a new ground of rejection.

PROCEDURAL HISTORY

Applicants filed the present application with 38 claims on 4 January 2001. On 15 June 2001, new claims 39-51 were added by Preliminary Amendment. In the first Office Action

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mailed 17 January 2002, all claims were substantively examined *without restriction*. Claims 18 and 31 were deemed allowable but objected to, and the rest were substantively rejected.

In response, on 17 April 2002, Applicants canceled claims 33, 39, 40, 41, 44 and 47-51, amended claims 17, 34, 42-43, 45 and 46, and added new claims 52-80. In a second and final Office Action mailed 3 July 2002, all claims were substantively examined again *without restriction*. Claims 18 and 31 were again deemed allowable but objected to, claims 62-80 were allowed and the rest were finally rejected.

In response, on 18 September 2002, Applicants filed an Amendment seeking to add two new drawing figures, cancel claims 53 and 54, amend the dependency of claims 55 and 56, and add new claim 81 (claim 54 rewritten in independent form). In an Advisory Action mailed 24 Sept 2002, the proposed amendment was not entered.

On 3 October 2002, Applicants filed another Amendment and Response, adding two new figures, canceling claims 53-61, and adding new claim 81. Applicants simultaneously appealed the rejection of claims 1-17, 19-30, 32, 34-38, 42, 43, 45, 46, 52, and 81. In a communication mailed 18 October 2002, the Examiner acknowledged the appeal and entered the amendment for purposes of the appeal, while disapproving one of the drawing corrections.

On 3 December 2002, Applicants filed their Appeal Brief. In a communication mailed 10 March 2003, the Examiner found the Appeal Brief defective for a variety of reasons, and in reply thereto, Applicants' Final Appeal Brief was filed on 2 April 2003.

In the paper mailed 20 June 2003, *after Applicants filed their Appeal Brief and corrected Appeal Brief*, the Examiner withdrew the final Office Action, reopened prosecution, and issued a non-final *restriction requirement*, asserting that two groups of claims (both allowed and unallowed) are patentably distinct, and that there are further patentably distinct species within one of the groups. In response, Applicants requested reinstatement of the appeal under 37 C.F.R. §1.193, and filed a supplemental Appeal Brief on 16 July 2003. In the paper mailed 6 October 2003, the Examiner considered Applicants' request for reinstatement to be not responsive to the Office Action mailed 20 June 2003, and gave Applicants one more month to make an election. Applicants now file this Petition to the Director to invoke supervisory authority.

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ARGUMENT

(1) THE EXAMINER, WITHOUT AUTHORITY, IS MANDATING ONE OF TWO PERMISSIBLE OPTIONS.

According to 37 CFR §1.193 and MPEP §1208.02, when prosecution was reopened with the non-final Office Action mailed 20 June 2003 after Applicants' Appeal Brief had been filed, Applicants had to exercise one of two options in order to avoid abandonment of the application: (1) file a reply under 37 CFR §1.111 or (2) request reinstatement of the appeal. The two options are disjunctive. That is, Applicants only have to take action under one of the two options. In the paper filed 16 July 2003, Appellants requested reinstatement of the appeal, along with the supplemental brief required under rule 37 CFR §1.192.

The Examiner did not respond to Applicants' request for reinstatement of the appeal. Instead, the Examiner is continuing to require Applicants to respond under 37 CFR §1.111 by making an election to the restriction requirement. In essence, the Examiner is attempting to force the Applicants to respond under 37 CFR §1.193(1), even though Applicants have permissibly responded under 37 CFR §1.193(2). This flies directly in the face of the instructions for handling an appeal under the rules. The Examiner's action is in violation of the rules.

Moreover, the Examiner's action in issuing a *restriction requirement* in response to Applicants' appeal brief is also in violation of the rules.

Under 37 CFR §1.193:

The primary examiner may, within such time as may be directed by the director, furnish a written statement in answer to appellant's brief....

Also, under MPEP §1208.02:

The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed.

No other options are provided in the rules or in the MPEP after an Appeal Brief is filed. Thus, when Applicants filed their Appeal Brief, the Examiner must either have (1) answered the appeal or (2) entered a new ground of rejection.

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In fact, the Examiner did neither. The restriction requirement is clearly not an answer to the Appeal Brief. The restriction requirement is also not a new ground of rejection. A new ground of rejection is a substantive rejection of the claims at issue based on previously uncited prior art. A restriction requirement is not a substantive rejection of the claims.

Consequently, Applicants are compelled to ask the Director to instruct the Examiner to either file an answer to Applicants' Appeal Brief or issue a new ground of rejection based on a rejection of the claims in view of new art.

(2) THE EXAMINER'S RESTRICTION REQUIREMENT IS UNTIMELY.

In addition to the restriction requirement not qualifying as a new ground of rejection, the entry of the restriction requirement at this late date, especially after an appeal has been filed, is clearly inappropriate. Since filing the application, Applicants have amended the claims five times, added 43 claims, and filed four substantive responses addressing all of the claims. The Examiner has examined them all, including at least *twice* examining the claims he now seeks to restrict. His examination included a substantive evaluation of both of Applicants' post final amendments before the Appeal Brief was filed, and he further evaluated the Appeal Brief before Applicants filed a second one. Not once did the Examiner raise any issue about restricting the claims, until after Applicants filed their Appeal Brief. Nothing in the appeal rendered the claims any more distinct than they had been so that the Examiner could not much earlier determine whether a restriction was proper.

According to MPEP §811:

...the examiner should make a proper restriction requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops. Before making a restriction requirement after the first office action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required.

The Examiner clearly did not make his restriction requirement as soon as the need developed. The last change to the claims occurred prior to the appeal. If Applicants' last amendment developed a need for a restriction, it occurred then, not after the Appeal Brief was filed.

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Moreover, there is no indication in the paper of 20 June 2003 (or any other paper in this case for that matter) that the Examiner has considered whether there will be a serious burden before making the restriction requirement. Failure to make a restriction as soon as any need developed (if it did), and failure to consider whether there will be a serious burden prior to making the restriction (if there is) renders the restriction itself untimely.

Most notably, the restriction requirement was issued *after* Applicants filed their Appeal Brief. 37 CFR §1.142(a) expressly states that a restriction requirement cannot be entered after a final action:

If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

The restriction requirement was made after the final action. In fact, the restriction requirement was made after the filing of the Appeal Brief. The Examiner's actions are clearly not in compliance with the rules.

In this case, that the Examiner withdrew the finality of the rejection cannot serve to make the restriction requirement comply with the rule. A benefit of the rule requiring the entry of the restriction requirement before a final action is that the Applicants are assured that all procedural hurdles to the allowability of the claims are behind them and that they can focus on the substance of the claims, especially if they are to appeal the claims. Knowing that a procedural hurdle cannot be used to derail or block the appeal process, Applicants are justified in expending the substantial resources in appealing the case. To permit the Examiner to circumvent the rule by withdrawing the finality of the rejection and entry a restriction requirement after the Appeal Brief is filed would eviscerate the basis for the rule.

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(3) THE EXAMINER'S REQUIREMENT DOES NOT MEET THE CRITERIA FOR PATENTABLY DISTINCT INVENTIONS.

Under MPEP §803, there are two criteria for a proper requirement of restriction between patentably distinct inventions: (a) the inventions must be independent or distinct as claimed; and (b) there must be a serious burden on the examiner if restriction is not required. Here, Applicants' amendments have created no serious burden on the Examiner. After all, he has already searched and examined all of the claims. No further searching will be required, at least because of any amendments filed by Applicants. Nowhere in the record does there appear any determination that there would be a serious burden on the Examiner if restriction were not required. Indeed, the Examiner has not even raised a *prima facie* showing of a serious burden. (see MPEP §803 Guidelines).

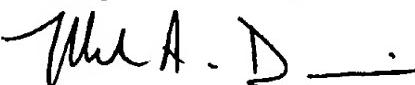
Because the Examiner's requirement for restriction in this case is untimely and fails to meet the criteria for a proper restriction, and because the Examiner fails to recognize Applicants' reinstatement of the appeal, Applicants respectfully request that the Director instruct the Examiner to do either one of two appropriate actions: (a) file an answer to Applicants' appeal or (b) enter a new ground of rejection.

Respectfully submitted,

Richard E. Vogel and Timothy J. Foltz

Dated: 11/6/03

By:


Mark A. Davis (Reg. No. 37,118)

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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 130)

Complete If Known

Application Number	09/681,099
Filing Date	January 4, 2001 FAX RECEIVED
First Named Inventor	Richard E. Vogel NOV 06 2003
Examiner Name	Joseph C. Merek
Art Unit	3727
Attorney Docket No.	70254-0328 PETITIONS OFFICE

METHOD OF PAYMENT (check all that apply)

 Check Credit card Money Order Other None
 Deposit Account:

Deposit Account Number	50-2003
Deposit Account Name	McGarry Bair PC

The Director is authorized to: (check all that apply)

-
- Charge fee(s) indicated below
-
- Credit any overpayments
-
-
- Charge any additional fee(s) or any underpayment of fee(s)
-
-
- Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee	
1002 340	2002 170	Design filing fee	
1003 630	2003 265	Plant filing fee	
1004 770	2004 385	Reissue filing fee	
1005 160	2005 80	Provisional filing fee	
SUBTOTAL (1) (\$)			

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	- 20 =	X	=	Fee from Extra Claims below	Fee Paid
Independent Claims	- 3 =	X	=		
Multiple Dependent					

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1202 18	2202 9	Claims in excess of 20	
1201 88	2201 43	Independent claims in excess of 3	
1203 290	2203 145	Multiple dependent claim, if not paid	
1204 88	2204 43	** Reissue independent claims over original patent	
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2) (\$)			

*or number previously paid, if greater. For Reissues, see above

3. ADDITIONAL FEES

Large Entity Fee Code (\$)	Small Entity Fee Code (\$)	Fee Description	Fee Paid
1051 130	2051 65	Surcharge - late filing fee or oath	
1052 50	2052 25	Surcharge - late provisional filing fee or cover sheet	
1053 130	1053 130	Non-English specification	
1812 2,520	1812 2,520	For filing a request for ex parte reexamination	
1804 920*	1804 920*	Requesting publication of SIR prior to Examiner action	
1805 1,840*	1805 1,840*	Requesting publication of SIR after Examiner action	
1251 110	2251 55	Extension for reply within first month	
1252 420	2252 210	Extension for reply within second month	
1253 850	2253 475	Extension for reply within third month	
1254 1,480	2254 740	Extension for reply within fourth month	
1255 2,010	2255 1,005	Extension for reply within fifth month	
1401 330	2401 165	Notice of Appeal	
1402 330	2402 165	Filing a brief in support of an appeal	
1403 290	2403 145	Request for oral hearing	
1451 1,510	1451 1,510	Petition to institute a public use proceeding	
1452 110	2452 55	Petition to revive - unavoidable	
1453 1,330	2453 665	Petition to revive - unintentional	
1501 1,330	2501 665	Utility issue fee (or reissue)	
1502 480	2502 240	Design issue fee	
1503 640	2503 320	Plant issue fee	
1460 130	1460 130	Petitions to the Commissioner	130
1807 50	1807 50	Processing fee under 37 CFR 1.17(q)	
1808 180	1808 180	Submission of Information Disclosure Stmt	
8021 40	8021 40	Recording each patent assignment per property (times number of properties)	
1809 770	2809 385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810 770	2810 385	For each additional invention to be examined (37 CFR 1.129(b))	
1801 770	2801 385	Request for Continued Examination (RCE)	
1802 900	1802 900	Request for expedited examination of a design application	
Other fee (specify)			
*Reduced by Basic Filing Fee Paid		SUBTOTAL (3) (\$ 130)	

(Complete if applicable)

Name (Print/Type)	Mark A. Davis	Registration No. (Attorney/Agent)	37,118	Telephone (616) 742-3500
Signature	<i>Mark A. Davis</i>		Date	November 6, 2003

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